

mutation is in the 5'-3' exonuclease domain of said polymerase, and further wherein said mutant *Thermotoga neapolitana* DNA polymerase is a Pol I-type DNA polymerase.

46. (previously added) A recombinant host cell comprising a DNA sequence encoding a mutant *Thermotoga neapolitana* DNA polymerase having a mutation that substantially reduces or eliminates 5'-3' exonuclease activity of said polymerase, wherein said mutation is in the 5'-3' exonuclease domain of said polymerase, and further wherein said mutant *Thermotoga neapolitana* DNA polymerase is a Pol I-type DNA polymerase.

47. (previously added) A method of producing a mutant *Thermotoga neapolitana* DNA polymerase, said method comprising:

(a) culturing a host cell comprising a gene encoding a mutant *Thermotoga neapolitana* DNA polymerase having a mutation that substantially reduces or eliminates 5'-3' exonuclease activity of said polymerase, wherein said mutation is in the 5'-3' exonuclease domain of said polymerase, and further wherein said mutant *Thermotoga neapolitana* DNA polymerase is a Pol I-type DNA polymerase;

(b) expressing said gene; and


(c) isolating said mutant *Thermotoga neapolitana* DNA polymerase from said host cell.

### **REMARKS**

In response to the Office Action mailed March 25, 2003, Applicants elect the claims in Group 1 (Claims 22-30, 40 and 44), with traverse. The present claims are copied from U.S. Patent No. 5,939,301, ("301") in order to preserve the right to provoke an interference proceeding with the patentees of the '301 patent. The claims from both Groups 1 and 2 were issued in the '301 patent. The Examiner has the discretion to waive the current restriction. In the present case, this discretion is called for. Separation of the claims into two applications as a result of the Restriction will result in the need to proceed with two separate interference proceedings. This is not economical for either party or the Patent Office, as the same issues will arise in both proceedings. Furthermore, the prior art in these cases is well understood (having been assessed in both the '301 patent prosecution and in the parent applications of the present application, which have been in prosecution since 1995)--with the same prior art

applying to both Groups of claims. In view of the above, Applicants request that the restriction be withdrawn.

Dated: May 27, 2003

  
David A. Casimir  
Registration No. 42,395

MEDLEN & CARROLL, LLP  
101 Howard Street, Suite 350  
San Francisco, California 94105  
608/218-6900